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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bianca Jewelry¹, Inc.
v.
Emmi, Inc.

Cancellation No. 92032305

Joseph D. Lewis of Barnes & Thornburg for Bianca Jewelry,
Inc.

Jonathan G. Gabriel, Esq. for Emmi, Inc.

Before Chapman, Rogers, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 18, 1997, respondent (Emmi, Inc.²) filed
application Serial No. 75326685 to register on the Principal
Register the following mark:

¹ The word "jewelry" appearing in petitioner's name and elsewhere
is spelled at least three different ways in various papers in the
record. Regardless of how the word is spelled in the record, we
will use the spelling "jewelry" for consistency.

² Respondent also does business under the name Universal Fine
Jewelry.



for goods identified as "jewelry consisting of precious metals and gems" in International Class 14.

On October 20, 1998, respondent's mark issued as Registration No. 2,197,738. The registration claims a date of first use and first use in commerce of April 1, 1997.

Petitioner (Bianca Jewelry, Inc.), on May 24, 2001, filed a petition to cancel respondent's registration on the ground that "Petitioner has used in interstate commerce the trademark BIANCA since long prior to, but not less than 15 years before, Registrant's date of first use of the trademark BIANCA" (Petition at 1). Respondent denied the salient allegations of the petition to cancel.

The Record

The record consists of the following items: the file of the involved registration; the trial testimony deposition of petitioner's president, Sarkis Danacian, with accompanying exhibits; the trial testimony deposition of respondent's principal, Edward A. Zohrabian, with accompanying exhibits; portions of the discovery deposition of Edward A. Zohrabian submitted by petitioner and a copy of that entire deposition submitted by respondent, both under

notices of reliance; the discovery deposition of Sarkis Danaciyani³ submitted by respondent under a notice of reliance; and copies of respondent's discovery responses, a jewelry show directory, and an Office action in another application submitted by petitioner under a notice of reliance.

Preliminary Matters

A party petitioning to cancel a federally registered trademark must plead that it has standing and that there is a valid ground for the cancellation of the registration. Young v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998) ("Section 14 has been interpreted as requiring a cancellation petitioner to show (1) that it possesses standing to challenge the continued presence on the register of the subject registration and (2) that there is a valid ground why the registrant is not entitled under law to maintain the registration") (internal quotation marks omitted).

For standing, petitioner asserts its ownership of common law rights in the mark BIANCA.

Under the rule of Otto Roth, a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through "whatever other type of use may have developed a trade identity." Otto Roth &

³ The depositions of Sarkis Danaciyani were conducted in Turkish and translated into English.

Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). The Otto Roth rule is applicable to trademark registration cancellation proceedings as well.

Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990) (full citation added).

In this case, petitioner claims priority because of its ownership and rights in the term BIANCA, which petitioner alleges is confusingly similar to respondent's registered mark BIANCA and design. Petitioner has made out a non-frivolous allegation of confusing similarity,⁴ and has therefore established standing.

Before we proceed to the discussion of priority, we address the likelihood of confusion issue.

Likelihood of Confusion

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567

⁴ The petition to cancel contained an allegation that respondent "cannot establish secondary meaning for its use of the mark BIANCA, which is descriptive as to its use of the mark 'BIANCA' for white platinum jewelry." Petition at 2. Respondent denied this allegation and the issue was not briefed by the parties. "Bianca" is the name of a friend of Mr. Danaciyan's daughter. Danaciyan dep. at 8. The evidence of record does not support a conclusion that the mark BIANCA is merely descriptive for petitioner's goods. Therefore, we conclude that petitioner's mark is distinctive as applied to petitioner's goods.

(CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

In this case, both respondent and petitioner use the mark BIANCA. Respondent's registration shows the mark BIANCA in stylized form.



Respondent's added stylization is not sufficient to distinguish the marks when the identical word is used in both marks. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of "The," "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion as to restaurant services); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). The words in both marks here would be pronounced the same and have the identical meaning, and in appearance, they would be very similar. Therefore, their overall commercial impressions would be very similar.

Another important consideration in a likelihood of confusion analysis is the relatedness of the goods of

petitioner and respondent. The identification of goods in respondent's registration reads "jewelry consisting of precious metals and gems." We must consider the goods as they are identified in the registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Petitioner's evidence shows that it has been using the mark in association with jewelry of all types, particularly bangles. See Danacian Ex. 1 at 2737 (gold jewelry) and Ex. 3 (bangles, "all jewelry 14k and 18k gold"). Petitioner's catalogs contain the title "Bianca Jewelry Bangle's [sic] Specialist"). Petitioner testified that, since about 1982, it has used the word BIANCA on "bracelet[s], flexible bracelets, earrings, rings, pendants or necklaces." Danacian dep. at 9. Respondent also sells a variety of jewelry items. See Zohrabian Ex. 39 (rings, necklaces, bangles, earrings, pendants, and bracelets).

Respondent's jewelry consisting of precious metals and gems and petitioner's jewelry of precious metals are very similar, and therefore, little, if any, distinction can be made on the basis of the goods. In addition, petitioner's and respondent's evidence shows that the jewelry of both parties does in fact include bangles consisting of precious

metals.⁵ "When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Because the goods of both parties are jewelry consisting of precious metals, the purchasers and channels of trade would overlap at least to some degree. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages"). While respondent argues that it sells "through retail stores" and petitioner uses its mark "solely in the wholesale trade" (Respondent's Brief at 11), respondent's registration does not exclude sales through the wholesale trade.⁶

⁵ Despite respondent's arguments to the contrary, respondent admits that the goods are at least in part identical. Respondent's Brief at 10 ("Petitioner specializes in gold bangles and *bracelets*... Respondent, on the other hand, sells a complete line of designer jewelry, from earrings, to rings to *bracelets* to necklaces to cuff links") (emphasis added).

⁶ The difference between the channels of trade appears to be even less distinct than asserted by respondent. Respondent admits that it sells through "large retail chains, such as Bailey Banks & Biddle, Macy's, JC Penney, Sterling, Mayers and Walmart." Respondent's Brief at 11; Zohrabian dep. at 41. Petitioner stipulated that it sells only at wholesale. Danaciyon dep. at 43. The difference between the two parties' marketing appears to be that petitioner sells to wholesalers who subsequently re-sell

Respondent also argues that "[i]nsofar as both Petitioner and Respondent actually sell to other wholesalers, there is no likelihood of confusion given the sophistication of the buyers and their relationship to the seller. Wholesalers in the jewelry trade are extremely sophisticated in general... Moreover, Mr. Danacian's customers are not major retail stores, but are more likely to be jewelers within the Armenian community." Respondent's Brief at 12. Assuming that jewelers are sophisticated purchasers, that fact does not mean that there is no likelihood of confusion. "Human memories even of discriminating purchasers ... are not infallible." In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting, Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). See also In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"). In this case, the identical word is used on

the jewelry without petitioner's mark on the goods, while respondent sells to wholesalers but respondent's mark is also promoted to retail customers. Danacian dep. at 44; Zohrabian Exhibits 51-58.

virtually identical goods. Even the most careful purchasers would normally be confused under these circumstances.

Respondent's evidence does not demonstrate that this would not be the case here.

Respondent also makes the additional arguments that (1) there is another similar mark registered to a third party and (2) there has been no actual confusion among petitioner's and respondent's customers. As to the first argument, even if there is another mark similar to petitioner's on the register that fact does not justify the continued registration of respondent's mark if petitioner establishes that it is the prior user of essentially the same mark for the same goods. While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to "justify the registration of another confusingly similar mark." In re J.M. Originals, 6 USPQ2d 1393, 1394 (TTAB 1988), citing, Plus Products v. Star-Kist Foods, Inc., 220 USPQ 541, 544 (TTAB 1983). As for the second argument, the test here is likelihood of confusion not actual confusion. Even if there has been no actual confusion, that fact would not demonstrate that there is no likelihood of confusion. Majestic Distilling, 65 USPQ2d at 1205 ("The lack of evidence of actual confusion carries little weight"). See also Giant Food, Inc. v. Nation's Foodservice, Inc., 710

F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). The lack of actual confusion is likely attributable to petitioner's small size and limited advertising. Danaciyan disc. dep. at 31.

In this case, when we consider all the likelihood of confusion factors, we conclude that confusion is likely. Both respondent and petitioner use the same word BIANCA on jewelry made of precious metals. The design in respondent's mark would not overcome the likelihood of confusion when the same word is used on virtually identical goods.

Priority

We now approach the central issue in this case, priority of use of the mark BIANCA. We start by noting that "a presumption of validity attaches to a service mark registration, and the party seeking cancellation must rebut this presumption by a preponderance of the evidence." West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ 1660, 1662 (Fed. Cir. 1994). See also Cerveceria Centroamericana S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[I]n a [trademark registration] cancellation for abandonment, as for any other ground, the petitioner bears the burden of proof. Moreover, the petitioner's burden is to establish the case for cancellation by a preponderance of the

evidence"); Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993).

The application that matured into respondent's registration was filed on July 18, 1997. That date is significant because respondent can rely on this date for its priority, and in order to prevail on priority, petitioner would have to establish an earlier date. 15 U.S.C.

§ 1057(c). See Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154, 156 n. 5 (TTAB 1985) ("The earliest date of first use upon which Intelsat can rely in the absence of testimony or evidence is the filing date of its application").⁷

Regarding petitioner's use of the mark, there are two questions: (1) when did petitioner or its predecessor begin using the mark and (2) can petitioner rely on this use of the mark?

The evidence establishes that an entity known as "Bianca Jewelry" existed long prior to the date of the filing date of the application that eventually matured into respondent's registration (July 18, 1997). Petitioner has submitted evidence of shipping receipts from 1992-96 from an

⁷ Respondent's application asserts a date of first use and first use in commerce of April 1, 1997. In this proceeding, respondent does not attempt to establish a date of first use that is significantly earlier than its filing date. Respondent's Brief at 6 ("Shortly prior to filing its application for registration in 1997, Respondent decided to create a 'designer collection' of platinum jewelry").

entity identified on the receipts as "Bianca" or "Bianca Jewelry." Danaciyan Ex. 1. In addition, this exhibit included receipts issued by an entity identified as "Bianca Jewelry - Manufacturers of Fine Jewelry Wholesale and Special Orders." These receipts include: #2737 dated June 16, 1987 for "14 kt. Gold Jewelry"; #2746 dated July 28, 1987 for "14 kt. Gold Jewelry"; and #4021 dated in 1987 for "Assorted Jewelry." Petitioner has submitted tags, labels, and a catalog evidencing use of the word BIANCA in association with jewelry prior to 1997. See Danaciyan dep. 15-20; Exhibits 2, 3, and 4. Petitioner's exhibits also include evidence that it did business with respondent prior to respondent's adoption of its BIANCA mark on jewelry. Danaciyan dep. at 29-34; Exhibits 5 and 5a.⁸

A related question affecting our determination on priority is whether the use of the mark BIANCA was by petitioner. Respondent argues that "Petitioner has no prior rights to 'Bianca' because Petitioner admits that it did not

⁸ This evidence of petitioner's sale of jewelry to respondent is evidence that petitioner was using the mark BIANCA JEWELRY on invoices prior to respondent (see, e.g. Danaciyan Ex. 5A (Receipt #6951)). We do not find that the sale of this jewelry establishes that respondent committed fraud in obtaining its registration when it failed to identify petitioner as person or firm that had a right to use the mark BIANCA as petitioner maintains. A fraud claim must be proved "to the hilt." Stocker v. General Conference Corp. of Seventh-Day Adventists, 39 USPQ2d 1385, 1391 (TTAB 1989). Inasmuch as the sales of jewelry were relatively small, respondent's actions in sending a cease and desist letter to petitioner (Danaciyan Ex. 51) is more indicative of respondent's lack of memory rather than a willful withholding

exist at the time that Respondent applied for registration of the mark." Respondent's Brief at 9. However, petitioner's president testified that he was doing business as Bianca Jewelry by 1982. Danaciyán dep. at 6.

Mr. Danaciyán operated Bianca Jewelry as a sole proprietorship starting by 1982. Danaciyán dep. at 7. The witness testified that Bianca Jewelry, Inc. began operating in February 1998 and before that the Bianca Jewelry sole proprietorship was doing the same type of business.

Danaciyán dep. at 6. Mr. Danaciyán is the president of Bianca Jewelry, Inc. Danaciyán dep. at 5. Both the sole proprietorship, Bianca Jewelry, and the corporation, Bianca Jewelry, Inc., operated from the same address from 1982 to 2002 (610 South Broadway, Los Angeles, California).

Danaciyán dep. at 7. Mr. Danaciyán has testified that he has used the mark BIANCA in a substantially continuous fashion since 1982.⁹ We find that that Bianca Jewelry, Inc. can rely on the use of Mr. Danaciyán's sole proprietorship, Bianca Jewelry's, use of the mark BIANCA.

Indeed, the pertinent inquiry in this case is simply whether a potential customer would have believed that someone was proclaiming to be engaged in restaurant services under the name "FAST EDDIE'S" at the time of the advertisements. That is undoubtedly what a potential customer would have believed in this case.

of material information from the Office. Petitioner's fraud claim, therefore, fails.

⁹ There is testimony that Mr. Danaciyán transferred the business for approximately one year in the early 1990's when he had surgery. Danaciyán dep. at 69.

Moreover, to the extent that the TTAB's decision suggests that West may be attempting to claim prior use for use that it cannot truthfully credit to itself, such a suggestion is nothing more than an unjustifiable refusal to recognize the connection between West Florida Seafood (the corporate name), "FAST EDDIE'S PLACE" (the trade name), and Edwin or E. Porter (the company's president). The TTAB erred in ignoring the rather obvious connection between these corporate, business, and personal "alter egos" operating as "FAST EDDIE'S."

West Florida Seafood, 31 USPQ2d at 1664. See also Gaylord Bros., Inc. v. Strobel Products Co., 140 USPQ2d 72, 74 (TTAB 1963) ("When he ceased doing business under one name and continued that same business under another name, previously used, title of the mark remained with him, as it was always with him. There is uncontradicted testimony that this person's individual business under the name Strobel Products Co. was taken over and continued by the Strobel Products Company, Incorporated").

Here, the evidence supports a finding that Mr. Danaciyan's sole proprietorship was using the mark BIANCA to identify its jewelry since long prior to 1997. Petitioner, a successor corporation established by Mr. Danaciyan, has continued this use of the mark on jewelry. Thus, we find that petitioner has established priority of use of the mark by a preponderance of the evidence. Therefore, because we have already determined that confusion is likely and now have found that petitioner

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has priority, petitioner is entitled to prevail on that issue.

Decision: The petition to cancel is granted, and Registration No. 2,197,738 will be cancelled in due course.